

M-16026 US

REMARKS

Claims 1-12 are pending in the present application. Claims 1-12 are rejected under 35 U.S.C. 103(a). The rejections are respectfully traversed in light of the following remarks, and reconsideration is requested.

Claims 1-3, 8, and 11-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe (U.S. Pub. No. 2002/0137537) in view of Hughes et al. (U.S. Pat. No. 6,625,425).

In rejecting claim 1, the Examiner states, in part, that Watanabe fails to teach that the mirror is directly facing and adjacent to a SIM card when the back cover is closed. The Examiner relies on Hughes for teaching a cellular phone in which the back cover 212 covers and directly faces an adjacent SIM card 204 when the back cover is closed. The Examiner states that "It would have been obvious to one of ordinary skill in the art . . . to provide the teaching of Hughes to the cellular phone of Watanabe so that the user can easily open the back cover for the purpose of replacing another SIM card."

Watanabe discloses a cell phone, in which all embodiments have a mirror facing a cosmetics container when the back cover or cosmetics container is closed. That is, during normal use, such as when the person is using the cell phone for placing or receiving calls or when the cell phone is not in use, the mirror and cosmetics container face each other in this closed position.

Hughes et al. disclose simply, as applied to claim 1, a cell phone with a detachable back cover 212 that, when closed, faces and is adjacent to a SIM card 202. (See Fig. 2 and corresponding text).

Applicant contends that there is no motivation to combine Watanabe with Hughes et al. As discussed above, Watanabe discloses a cell phone in which a mirror faces a cosmetics container when the cover is closed. The purpose is that a user can access cosmetics in the cell

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M-16026 US

phone and use the mirror to help apply the cosmetics if desired. So, by opening up the back cover, the cell phones functions as a compact in that a mirror is attached to an area containing cosmetics. (See, Figs. 4, 7, 11, and 14). However, by applying the teach of Hughes et al. to Watanabe, as the Examiner suggests, the main purpose of Watanabe is no longer possible. If a SIM card were placed, such that the mirror faces and is directly adjacent to the SIM card when the cover is closed, the user would not be able to access the cosmetics case. In fact, Applicant is not even sure how Watanabe and Hughes would be combined. If the SIM card is placed over the cosmetics case, the cosmetics case cannot be accessed. If the SIM card replaces the cosmetics case, the whole purpose of Watanabe is destroyed. If the SIM card were placed next to the cosmetics case, this would greatly reduce the size of the cosmetics case, possibly to the extent of being unusable. With this last scenario, there is no suggestion of Watanabe that this would even be desirable. As seen from Hughes et al., the SIM card occupies a very large portion of the cell phone body.

Thus, Applicant believes that the obviousness rejection under 35 U.S.C. § 103 cannot be established by combining the teachings of Watanabe and Hughes because there is no suggestion or motivation in the cited references for combining Watanabe and Hughes as discussed above.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Applicant believes that it is clear that such suggestion or incentive is not present in either Watanabe or Hughes, since there is

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M-16026 US

no teaching in either reference to support the combination and even if such a combination were formed, the purpose of Watanabe would no longer be present.

Furthermore, the "statute, §103, requires much more, i.e., that it would have been obvious to produce the claimed invention at the time it was made without the benefit of hindsight." Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1575, 1 USPQ2d 1081, 1087 (Fed. Cir. 1986). "When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) *citing* ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577 & n.14, 221 USPQ 929, 933 & n.14 (Fed. Cir. 1984). Applicant believes the motivation to combine Watanabe with Hughes is derived from Applicant's invention since there is no suggestion in the cited references for the desirability of such a combination.

Therefore, for the above reasons, Applicant contends that the combination of Watanabe and Hughes is improper, and thus, claim 1 is patentable over the cited references.

Claims 2, 3, 8, and 11-12 depend on claim 1 and would thus be patentable over Watanabe and Hughes for at least the same reasons as claim 1.

Claims 4, 7, and 10 were rejected as being unpatentable over Watanabe in view of Hughes as applied to claim 1 and further in view of Leon et al. (U.S. Pat. No. 5,896,277). Leon et al. was cited for disclosing a slidably detachable back cover (claims 4 and 10) and a back cover that can be completely removed from the front portion (claim 7). However, Leon does not teach or suggest that a "mirror is directly facing and adjacent to a SIM card when the back cover is closed", as recited in claim 1. Because claims 4, 7, and 10 depend on claim 1 and Leon does not remedy the deficiencies of claim 1, claims 4, 7, and 10 are patentable over Watanabe in view of Hughes and Leon for at least the same reasons as claim 1.

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M-16026 US

Claims 5-6 and 9 were rejected as being unpatentable over Watanabe in view of Hughes as applied to claim 1 and further in view of Horne (U.S. Pat. No. 5,983,083). Horne is cited for teaching the back cover can be attached to the front portion by a clip (claim 5), the latch is located on one of the four sides of the cell phone (claim 6), and a spring mechanism to couple the front portion with the back cover (claim 9). However, as with Leon, Horne does not teach or suggest that a "mirror is directly facing and adjacent to a SIM card when the back cover is closed". Since claims 5-6 and 9 depend on claim 1, claims 5-6 and 9 are patentable over the cited references for at least the same reasons as claim 1 discussed above.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections to claims 1-12 under 35 U.S.C. § 103(a).


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M-16026 US

CONCLUSION

For the foregoing reasons, Applicant believes pending claims 1-12 are allowable, and a notice of allowance is respectfully requested. If the Examiner has any questions regarding the application, the Examiner is invited to call the undersigned Attorney at (949) 752-7040.

Certification of Facsimile Transmission	
I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.	
 Monique M. Butler	<u>October 4, 2006</u> Date of Signature

Respectfully submitted,


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